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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,329	06/10/2005	Atsushi Nakajima	05368/HG	1547
1933 7590 05/25/2007 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			EXAMINER SHAH, MANISH S	
			ART UNIT 2853	PAPER NUMBER
			MAIL DATE 05/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,329

Applicant(s)

NAKAJIMA, ATSUSHI

Examiner

Manish S. Shah

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/10/05; 2/15/06; 6/2/06</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushima (# JP 05-186725).

Matsushima discloses an inkjet recording method for recording images on the base material using the UV-setting ink (see Abstract; [0020]-[0025]), wherein the ink composition includes colorant, UV polymeric compound, photo initiator and water ([0020]-[0025]), wherein the UV rays are applied to the jetted inks within a contact time in which the rate of ink transfer to the base material ([0024]-[0025]). They also disclose that the method further comprises the process of removing the water-based medium after hardening the ink by ultraviolet ray ([0024]).

Matsushima differs from the claim of the present invention is that the rate of the ink transfer to the base material is less than 20 ml/mm² and it more than 20 ml/mm² if the contact time of the ink on the base material is 2 seconds.

It would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate the rate of the ink transfer to the base material is less than 20 ml/mm² and it more than 20 ml/mm² if the contact time of the ink on the

base material is 2 seconds, since it has been held that it is not inventive to discovering and optimum value or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA1955).

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (# US 2003/0179270).

Yamamoto et al. discloses an inkjet recording method for recording images on the base material using the UV-setting ink (see Abstract; [0009]-[0013]), wherein the ink composition includes colorant, UV polymeric compound, photo initiator and water ([0042]-[0044]), wherein the UV rays are applied to the jetted inks within a contact time in which the rate of ink transfer to the base material (figure: 6a; [0053]; [0076]). They also disclose that the method further comprises the process of removing the water-based medium after hardening the ink by ultraviolet ray ([0081]-[0082]).

Yamamoto et al. differs from the claim of the present invention is that the rate of the ink transfer to the base material is less than 20 ml/mm² and it more than 20 ml/mm² if the contact time of the ink on the base material is 2 seconds.


It would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate the rate of the ink transfer to the base material is less than 20 ml/mm² and it more than 20 ml/mm² if the contact time of the ink on the base material is 2 seconds, since it has been held that it is not inventive to discovering and optimum value or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA1955).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Manish S. Shah
Primary Examiner
Art Unit 2853

MSS

5/22/07